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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,603	02/06/2001	Robert G. Roodman	3576-010027	3170

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EXAMINER

CINTINS, IVARS C

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 03/26/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/777,603

Applicant(s)

Roodman et al.

Examiner

Ivars Cintins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 16, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-11, and 15-35 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-11, 15-19, and 22-35 is/are rejected.
- 7) ☒ Claim(s) 20 and 21 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

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Upon reconsideration, particularly in view of Applicant's remarks presented in the response filed December 16, 2002, the restriction requirement advanced in the previous Office action is hereby withdrawn.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, 4-9, 29 and 30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The limitation that the activated carbon is "non-ion exchanging" (claim 1, line 1) does not appear to be supported by the disclosure originally filed, and hence constitutes **new matter**.

Claims 23, 25-28, 34 and 35 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. It appears essential that the pH of the aqueous solution passing through the bed of activated carbon experiences a pH deviation of less than 1 pH unit (see page 3, paragraph

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0012, of the specification); and since this critical feature has not been recited in claims 23, 25-28, 34 and 35, these claims are not enabled by the disclosure. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 23, 25-28, 34 and 35 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 23, 25-28, 34 and 35 fail to recite the apparently essential limitation that the pH of the aqueous solution passing through the bed of activated carbon experiences a pH deviation of less than 1 pH unit; and therefore, these claims fail to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country,

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more than one year prior to the date of application for patent in the United States.

Claims 1, 7-11 and 29-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Roy (U.S. Patent No. 5,348,755). The reference discloses impregnating activated carbon with a carboxylic acid of the type recited (see col. 11, line 41), in the recited amount (see col. 11, line 62); and therefore, this reference material will inherently exhibit the recited pH characteristic.

Claims 17, 23 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Helmig (U.S. Patent No. 5,437,797). The reference discloses removing impurities from an aqueous system with an activated carbon impregnated with a carboxylic acid (see col. 2, lines 23-24); and therefore, this material will inherently exhibit the recited pH characteristic.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 4-11, 15, 16 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kashiba (U.S. Patent No.

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6,114,162). Kashiba discloses impregnating activated carbon with an aqueous solution of a carboxylic acid of the type recited (see col. 2, lines 36-40). This reference further teaches (see col. 2, line 53) that the source of the activated carbon can be coal, wood or coconut shells. Accordingly, this reference discloses the claimed invention with the exception of the amount of carboxylic acid and water present in the composition, the duration of contact between the carboxylic acid and activated carbon (claim 15), and the drying time and temperature employed (claim 16). However, the exact amount of carboxylic acid and water present in the reference composition, the exact amount of time that the carboxylic acid and activated carbon are contacted with one another, and the exact drying time and temperature employed are not seen to materially affect the overall results of the reference system, or to produce any new and unexpected results; and are therefore deemed to be obvious matters of choice, which are insufficient to patentably distinguish the claims.

Claims 6, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roy. Roy discloses the claimed invention with the exception of, the source of the activated carbon (claim 6), the duration of contact between the carboxylic acid and activated carbon (claim 15), and the drying time and temperature

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employed (claim 16). However, the exact source of the activated carbon in this reference, the exact amount of time that the carboxylic acid and activated carbon are contacted with one another, and the exact drying time and temperature employed are not seen to materially affect the overall results of the reference system, or to produce any new and unexpected results; and are therefore deemed to be obvious matters of choice, which are insufficient to patentably distinguish the claims.

Claims 1, 2, 4-6, 9-11, 15, 16, 18, 19, 22, 24, 25 and 28-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helmig. Helmig discloses the claimed invention with the exception of the amount of carboxylic acid and water present in the composition, the source of the activated carbon, the duration of contact between the carboxylic acid and activated carbon (claim 15), and the drying time and temperature employed (claim 16). However, the exact amount of carboxylic acid and water present in the reference composition, the exact source of the activated carbon in this reference, the exact amount of time that the carboxylic acid and activated carbon are contacted with one another, and the exact drying time and temperature employed are not seen to materially affect the overall results of the reference system, or to produce any new and unexpected results;

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and are therefore deemed to be obvious matters of choice, which are insufficient to patentably distinguish the claims.

Claims 1, 6-11, 15, 16 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinhead et al. (U.S. Patent No. 5,626,820). Kinhead et al. discloses impregnating activated carbon with an aqueous solution of a carboxylic acid of the type recited (see col. 9, lines 26-27). This reference further teaches (see col. 9, line 15) that the source of the activated carbon can be coal or coconut shells. Accordingly, this reference discloses the claimed invention with the exception of the amount of carboxylic acid present in the composition, the duration of contact between the carboxylic acid and activated carbon (claim 15), and the drying time and temperature employed (claim 16). However, the exact amount of carboxylic present in the reference composition, the exact amount of time that the carboxylic acid and activated carbon are contacted with one another, and the exact drying time and temperature employed are not seen to materially affect the overall results of the reference system, or to produce any new and unexpected results; and are therefore deemed to be obvious matters of choice, which are insufficient to patentably distinguish the claims.

Claims 20 and 21 are objected to as being dependent upon a rejected base claim, but would be allowed if rewritten in

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independent form to include all of the limitations of the base claim and any intervening claims.

Applicant's arguments filed December 16, 2002 have been noted and carefully considered but are not deemed to be persuasive of patentability. Applicant argues that the references of record fail to disclose an activated carbon which has the property that water passing through this carbon experiences a pH deviation of less than 1 pH unit. It is pointed out, however, that each of the above noted references discloses an activated carbon impregnated with a carboxylic acid. Roy even teaches Applicant's most preferred carboxylic acid (see page 6 of the specification, paragraph 0023, last two lines; and col. 11, line 41 of Roy), and further teaches impregnating the activated carbon such that it contains the recited weight percentage of carboxylic acid (see col. 11, line 62). Therefore, it would appear that these reference materials will inherently exhibit the recited pH characteristic, for the same reason that Applicant's material exhibits this pH characteristic. Mere recitation of a newly discovered function or property that is inherently possessed by things in the prior art does not cause a claim drawn to those things to distinguish over the prior art. *General Electric. Co. v Jewel Incandescent Lamp Co.*, 67 USPQ 155 (1945);

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In re Oelrich, 212 USPQ 323 (C.C.P.A. 1981); *In re Best*, 195 USPQ 430 (C.C.P.A. 1977); *In re Swinehart*, 169 USPQ 226 (C.C.P.A. 1971).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to I. Cintins whose telephone number is (703) 308-3840. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

The fax phone numbers for this art unit are: (703) 872-9311 for "Official" faxes after Final Rejection; (703) 872-9310 for all other "Official" faxes; and (703) 872-9492 for "Draft" and other "Unofficial" faxes.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.


Ivars C. Cintins
Primary Examiner
Art Unit 1724

I. Cintins
March 24, 2003